## REMARKS

Claims 1-62 are pending. Claims 1-62 were finally rejected under 35 U.S.C. § 102(e) as being anticipated by Breese *et al.* (U.S. Pat. No. 6,006,218, hereinafter referred to as "Breese").

***The Finality of the Office Action Was Improper and Should be Withdrawn***

MPEP § 706.07 states:

> "Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection."

The first Office action applied Breese as anticipating every one of the elements/claim limitations recited in all 62 claims. In reply to the first Office action and in accordance with the controlling case laws, *infra*, applicants pointed out, with respect to pertinent claim limitations, what Breese does **not** disclose or suggest. No claim amendments were presented in the previous Reply because original claims recite novel elements/limitations sufficient to distinguish Breese.

MPEP § 2131 states:

> "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently describe, in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USP2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicants respectfully submit that Breese simply does **not** show or suggest an identical invention in as complete detail as is contained in the claims as set forth in the present application. At the minimum, Breese failed to teach or suggest claim limitations such as "**estimating parameters of a learning machine, wherein the parameters define a**

**User Model** ...," as explicitly recited in independent claims 1 and 32. This is particularly pointed out in the previous Reply, which is incorporated herein by reference.

MPEP § 706.07 states:

> "In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed, and any such grounds relied on in the final rejection should be carefully reviewed, and any such grounds relied on in the final rejection should be reiterated. They must also be clearly developed to such an extent that applicant may readily judge the advisability of an appeal unless a single previous Office action contains a complete statement supporting the rejection.

Applicants respectfully submit that the finality was premature inasmuch as there **remain outstanding grounds of rejection of record not clearly developed to such an extent that applicants may readily judge the advisability of an appeal**. For example, independent claim 1 recites "estimating parameters of a learning machine, wherein the parameters define a User Model..." There are three limitations here, "a learning machine," "parameters," and "a User Model." All three limitations, as well as the deterministic relationship among them (i.e., the User Model is defined by the parameters of the learning model) *must* be present in Breese for an anticipatory type of rejection to stand. The cited columns of Breese refer to a database (storage) that has information (stored data) about the user and the user's interests [Office action, page 14, 2nd para.]. It is not clear at all how such a database *anticipates* or is *identical* to the claimed "User Model," which, according to the particular teaching of the present application, is a function defined by a set of parameters of a learning machine [Spec. page 14, 2nd para.; Fig. 3].

**A rejection under 35 U.S.C. § 102(e) simply does not stand if the reference relied upon fails to disclose, either expressly or inherently, an identical invention in as complete detail as contained in the claims, *supra*.** Thus, to obviate the 102(e) rejections, **applicants particularly pointed out, on pages 2-9 of the previous Reply, the specific limitations of the claims not disclosed in Breese**, e.g., "analyzing a document *d* to identify properties of the document," "selecting in a group of users an expert user in an area of expertise," "finding an expert User Model among User Models of the group of users," "initializing the User Model by selecting a set of predetermined

parameters of a prototype user selected by the user."

Clearly, these specific arguments do not amount to a general allegation, as the Office action has alleged. Contrary, they clearly show that, by pointing out what Breese does not teach or suggest, the language of the claims patentably distinguish them from Breese, in compliance with 37 CFR 1.111(b). Therefore, at least the aforementioned claim limitations should have been considered.

Since the final Office action did not take into consideration of these claim limitations which have been submitted to be not disclosed and not anticipated by Breese, the finality of the Office action is submitted to be premature and should be withdrawn.

> "The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application," *id.*

Since the final rejection did not include a rebuttal of all arguments raised in Applicants' previous Reply with respect to the claim limitations not disclosed in Breese, Applicants are unable to develop a clear issue or readily judge the advisability of an appeal.

> "The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal." MPEP 706.07.
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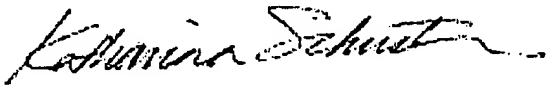
> "The examiner must ... address any arguments presented by the applicant which are still relevant to any references being applied." MPEP 707.07.

In view of the foregoing, applicants therefore respectfully request that the examiner withdraws the finality of the Office action.

Applicants further respectfully submit that claims 1-62 as originally filed recite subject matter not reached by Breese under 35 U.S.C. 102(e) and are therefore allowable. The present Request is a bona fide attempt to forward the present application to allowance.

The examiner is earnestly invited to telephone the undersigned at 650-331-8413 to discuss matters pertaining to the present application or an examiner's Amendment. **Any suggested actions that would accelerate prosecution and move the present application to a condition for allowance are much appreciated.**

Respectfully submitted,



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